

Express Mail No. EV475143180US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	6656
Application No.:	10/539,660		
Int'l Appln. No.:	PCT/CH02/00705	I.A. Filing Date:	December 17, 2002
For:	INTERVERTEBRAL IMPLANT WITH TILTABLE JOINT PARTS	Attorney Docket:	8932-1180-999 (new) (formerly LUS-16090)

New York, New York 10017  
September 14, 2006

Hon. Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION FOR FILING BY OTHER THAN  
ALL INVENTORS UNDER 37 C.F.R. § 1.47(a)**

Sir:

Pursuant to 37 C.F.R. § 1.47(a), Robert Frigg, Dominique Burkard, Beat Lechmann, Paul Pavlov, and Robert Mathys Jr., joint inventors of the above-identified patent application, hereby petition for entry of their Declaration that they have executed on behalf of themselves and on behalf of Max Aebi, a joint inventor who has refused to join in the above-identified application.

In support of this Petition, applicants submit herewith a First Statement Of Facts by Carrie A. McPherson, a patent paralegal employed by Synthes, Inc., the controlling

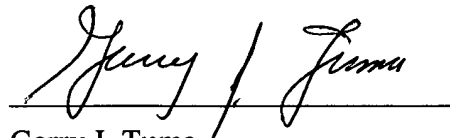
corporation of the assignee of the above-identified application, and a Second Statement Of Facts by Garry J. Tuma, the undersigned attorney for applicants. The two Statements detail proof of pertinent facts showing that Max Aebi has refused to join in the above-identified application.

The last known address of Max Aebi is as follows:

MEM Research Center  
University of Bern  
Stauffacherstrasse 78  
CH-3014 Bern  
Switzerland

Applicants respectfully request that this Petition be granted and that their Declaration be entered.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Garry J. Tuma", is written over a horizontal line.

Garry J. Tuma  
Registration No. 40,210  
Attorney for Applicants

JONES DAY  
Customer No. 51832  
222 East 41st Street  
New York, New York 10017  
(212) 326-3939

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	6656
Application No.:	10/539,660		
Int'l Appln. No.:	PCT/CH02/00705	I.A. Filing Date:	December 17, 2002
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Hon. Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**FIRST STATEMENT OF FACTS  
IN SUPPORT OF A  
PETITION FOR FILING BY OTHER THAN  
ALL INVENTORS UNDER 37 C.F.R. § 1.47(a)**

Sir:

I, Carrie A. McPherson, a patent paralegal employed by Synthes, Inc., the controlling corporation of the assignee of the above-identified patent application, make this Statement in support of a Petition For Filing By Other Than All Inventors Under 37 C.F.R. § 1.47(a), submitted concurrently herewith, in connection with this application.

The joint inventors of the subject matter claimed in the above-identified patent application are Robert Frigg, Dominique Burkard, Beat Lechmann, Paul Pavlov, Robert Mathys Jr., and Max Aebi. All joint inventors except Max Aebi have executed a Declaration,

which I understand is being submitted concurrently herewith in reply to a February 14, 2006 Notification Of Missing Requirements Under 35 U.S.C. § 371.

On August 22, 2006, I forwarded via e-mail to joint inventor Max Aebi, at his last known e-mail address of max.aebi@memcenter.unibe.ch, a copy of the above-identified patent application and a Declaration. In my e-mail, I asked Dr. Aebi to indicate whether or not he is able/willing to sign the Declaration, and if so, to review, sign and date the Declaration and return it to me preferably before September 12, 2006. I attach as Exhibit A a copy of my August 22, 2006 e-mail to Dr. Aebi.

I also attach as Exhibit B copies of the delivery status notification e-mail and attached text files that I received, indicating that my August 22, 2006 e-mail to Dr. Aebi was successfully delivered.

As of this date, I have not received an executed Declaration or a reply to my August 22, 2006 e-mail.

Respectfully submitted,

September 14, 2006  
Date

Carrie A. McPherson  
Carrie A. McPherson  
Patent Paralegal  
Synthes, Inc.  
1302 Wrights Lane East  
West Chester, Pennsylvania 19380  
(610) 719-5231

Attachments: Exhibits A and B



<Mcperson.Carrie@synthes.  
com>

08/22/2006 11:04 AM

To <max.aebi@memcenter.unibe.ch>

cc <Rauker.Robert@synthes.com>

bcc

Subject FW: PLEASE REVIEW AND REPLY Documents for  
execution - Our Ref. 00093-05PUS1 (JD Ref.  
8932-1180-999)

Dr. Max Aebi  
Director MEM Research Center for Orthopedic Surgery  
Institute of Evaluative Research in Orth. Surgery  
University of Bern  
Stauffacherstrasse 78  
CH-3014 Bern

Re: U.S. Patent Application No. 10/539,659  
Filed June 14, 2005  
Corresponding to PCT/CH02/00704  
Titled "Intervertebral Implant With Joint Parts Mounted On  
Roller Bodies"  
(00070-05PUS1; 8932-1179-999; LU1981)

U.S. Patent Application No. 10/539,660  
Filed June 14, 2005  
Corresponding to PCT/CH02/00705  
Titled "Intervertebral Implant With Tilttable Joint Parts"  
(00093-05PUS1; 8932-1180-999; LU1982)

U.S. Patent Application No. 10/538,542  
Filed June 10, 2005  
Corresponding to PCT/CH02/00706  
Titled "Intervertebral Implant Comprising Joint Parts That Are  
Mounted To Form A Universal Joint"  
(00083-05PUS1; 8932-1181-999; LU1983)

U.S. Patent Application No. 10/538,950  
Filed June 14, 2005  
Corresponding to PCT/CH02/00707  
Titled "Intervertebral Implant"  
(00082-05PSU1; 8932-1182-999; LU1984)

Dear Dr. Aebi:

Attached please find a Declaration for each of the above-identified patent applications in which you are named as an inventor. Also attached is a copy of each application as filed in the U.S. Patent and Trademark Office.

We understand from the University of Bern that you are not permitted to sign the Declarations. Please confirm that you are following the University's instructions in your refusal to sign or if you otherwise cannot or will not sign the Declarations (you do not have to tell us why).

If, however, you are able/willing to sign the Declarations, please review the attached applications and, if they are in order, please sign and date the Declarations where indicated. If any minor changes need to be made to your name and address, please make the corrections and then

initial and date the changes.

Please return the executed Declarations to me at your earliest convenience and preferably before September 12, 2006.

It is important that you let us know whether or not you are willing to execute the attached Declarations. If you refuse, the U.S. Patent and Trademark Office has a special procedure we can follow.









With best regards.

Carrie

Carrie A. McPherson  
Patent Paralegal  
Synthes, Inc.  
1302 Wrights Lane East  
West Chester, PA 19380  
Ph: 610-719-5231  
Fax: 610-719-5143  
mailto:mcperson.carrie@synthes.com

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10539,659 Application as filed.pdf	10539,659 Declaration.pdf	10539,660 Application as filed.PDF	10539,660 Declaration.pdf
			
10538,542 Application as filed.pdf	10538,542 Declaration.pdf	10538,950 Application as filed.pdf	10538,950 Declaration.pdf

From: E-mail Administrator - US  
Sent: Tuesday, August 22, 2006 11:05 AM  
To: McPherson, Carrie  
Subject: Delivery Status Notification (Relay)

This is an automatically generated Delivery Status Notification.

Your message has been successfully relayed to the following recipients,  
but the requested delivery status notifications may not be generated by  
the destination.

max.aebi@memcenter.unibe.ch



ATT1860615.txt ATT1860616.txt

ATT1860615.txt

Reporting-MTA: dns;netmail.synthes.com  
Received-From-MTA: dns;us01-exchange2.synthes.com  
Arrival-Date: Tue, 22 Aug 2006 11:04:24 -0400

Final-Recipient: rfc822;max.aebi@memcenter.unibe.ch  
Action: relayed  
Status: 2.5.0

ATT1860616.txt

From: <Mcpherson.Carrie@synthes.com>  
To: <max.aebi@memcenter.unibe.ch>  
Message-ID: <E4A1E544C8F52D42A6F6DDF256FA6AF501C96626@us01-exchange2.synthes.com>  
Subject: FW: PLEASE REVIEW AND REPLY Documents for execution - Our Ref. 00093-05PUS1 (JD Ref. 8932-1180-999)



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**PATENT APPLICATION**

Applicants:	Max Aebi et al.	Confirmation No.:	6656
Application No.:	10/539,660		
Int'l Appln. No.:	PCT/CH02/00705	I.A. Filing Date:	December 17, 2002
For:	INTERVERTEBRAL IMPLANT WITH TILTABLE JOINT PARTS	Attorney Docket:	8932-1180-999 (new) (formerly LUS-16090)

Hon. Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SECOND STATEMENT OF FACTS  
IN SUPPORT OF A  
PETITION FOR FILING BY OTHER THAN  
ALL INVENTORS UNDER 37 C.F.R. § 1.47(a)**

Sir:

I, Garry J. Tuma, the undersigned attorney for applicants, make this Statement in support of a Petition For Filing By Other Than All Inventors Under 37 C.F.R. § 1.47(a), submitted concurrently herewith, in connection with the above-identified patent application.

The joint inventors of the subject matter claimed in the above-identified patent application are Robert Frigg, Dominique Burkard, Beat Lechmann, Paul Pavlov, Robert Mathys Jr., and Max Aebi. All joint inventors except Max Aebi have executed a Declaration, which is being submitted concurrently herewith in reply to a February 14, 2006 Notification Of Missing Requirements Under 35 U.S.C. § 371.

09/21/2006 ATRAN1 00000116 503013 10539660

02 FC:1463 200.00 DA

On August 22, 2006, after receiving a copy of Ms. Carrie A. McPherson's e-mail of even date to joint inventor Max Aebi (please see Ms. McPherson's Statement Of Facts submitted concurrently herewith), I performed an Internet search to confirm Dr. Aebi's mailing and e-mail addresses.

At the University of Bern's Web site, I confirmed that Dr. Aebi is the director of the Institute for Evaluative Research in Orthopaedic Surgery, his e-mail address is max.aebi@memcenter.unibe.ch, and his mailing address is as follows:

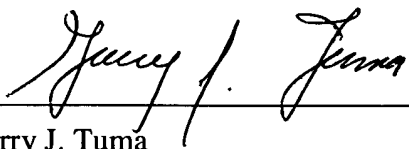
MEM Research Center  
University of Bern  
Stauffacherstrasse 78  
CH-3014 Bern  
Switzerland

See Exhibits 1-3; emphasis added.

I also attach as Exhibits 4 and 5, respectively, copies of August 10 and 16, 2005 letters from our foreign agent (Dr. Lusuardi AG) to applicants' former attorney (David E. Spaw, Esq., of Rankin, Hill, Porter & Clark LLP) indicating that joint inventor Max Aebi was already at that time refusing to sign any papers related to this patent application.

Respectfully submitted,

September 14, 2006

  
\_\_\_\_\_  
Garry J. Tuma  
Registration No. 40,210  
Attorney for Applicants

JONES DAY  
Customer No. 51832  
222 East 41st Street  
New York, New York 10017  
(212) 326-3939

Attachments: Exhibits 1-5

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The Maurice E. Müller Institute for Biomechanics (MIB) was established as a joint venture between the Maurice E. Müller Foundation and the Medical Faculty of the University of Bern when Prof. M.E. Müller retired, in 1981, as Chairman of the Department of Orthopaedic Surgery at the Inselspital. The Maurice E. Müller Institute for Biomechanics attained the legal status of a full University Institute on January 1st, 1995. The MIB was directed from 1981 until 1988 by Prof. Stephan S. Perren and from 1989 until 2003 by Prof. Ernst B. Hunziker.

In 2003 the MIB was dissolved and its parts were restructured: Prof. Hunziker became Director of the newly formed ITI Research Institute for Dental and Skeletal Biology and Prof. Lutz Nolte, a member of the MIB team since 1993, formed the new Institute for Surgical Technology and Biomechanics (ISTB). In conjunction with the newly created Institute for Evaluative Research in Orthopaedic Surgery (IEFO, formerly MEM-CED) directed by Prof. Max Aebi, the ISTB forms the University of Bern's M.E. Müller Research Center for Orthopaedic Surgery.

Together with clinical partners, this center realizes a unique concept for an integrated research continuum in the field of musculoskeletal science, from the bench (basic science), to the bedside (clinical application), and beyond (outcome).

In mid-2004 the MEM Research Center moved to its own facilities in the Wankdorf district of Bern. The 'new' building is actually a historical landmark, the Leinenweberei Schwob, which used to house a textiles manufacturing plant and in more recent times the Mechanical Engineering Division of the Fachhochschule Bern (University of Applied Science, )

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Edith	Röösli
Franziska	Schöni
Lukas	Staub
Thomas	Steffen
Özgür	Tamcan
Marcel	Widmer
Heidi	Zimmermann
Irene	Zintel



Many people have joined and left us over the years.  
For a list of former co-workers, click here.

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MEM Research Center



Prof. Max Aebi, Dr. med, Dr. h.c.

**u<sup>b</sup>**

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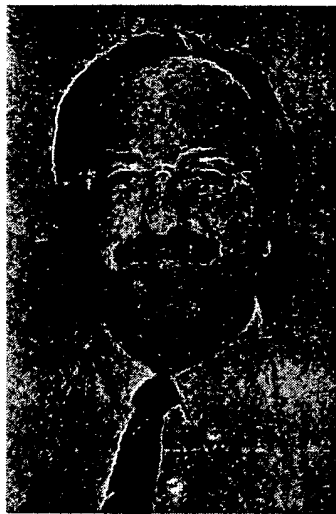
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**Position:** Director

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**Dr. Lusuardi AG**

Patentanwaltsbüro

European Patent Attorneys

Conseils en propriété intellectuelle

Per telecopier only

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Bank UBS AG  
CH-8077 Zürich  
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Rankin, Hill, Porter & Clark LLP  
Att. to Mr. Spaw  
4080 Erie Street  
Willoughby, Ohio 44094- 7836  
USA

Ihr Zeichen	Ihr Brief vom	Unser Zeichen	Datum	August 10, 2005
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LUS-16090

1982/US

**Re.: New national phase of PCT/CH02/00705 in the USA for  
„Intervertebral implant with tiltable joint parts“  
in the name of Mathys Medizinaltechnik AG**

Dear Mr. Spaw,

Herewith we are informing that there are some internal problems between the applicant and the Inventor Prof. Max Aebi.

The reason of this problems is that Prof. Aebi is not willing to sign any documents in order to transfer the rights of the above mentioned Patent Application to the applicant.

Under this circumstances, we kindly ask you to prepare a respective document (Affidavit) to be signed by Mathys Medizinaltechnik AG (Mr. Robert Frigg, Chief Technology Officer), which enables the transfer of the above application to the applicant.

The outstanding Documents signed by the other Inventors will be sent to you as soon as possible.

Should you required more detail information, please let us know.

Looking forward to hearing from you, we remain with best regards.

Yours sincerely,

*P. Kaiser*

**Dr. Lusuardi AG**

Patentanwaltsbüro

European Patent Attorneys

Conseils en propriété intellectuelle

Air mail

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Rankin, Hill, Porter & Clark LLP  
Att. to Mr. Spaw  
4080 Erie Street  
Willoughby, Ohio 44094- 7836  
USA

Ihr Zeichen

Ihr Brief vom

Unser Zeichen

Datum

August 16, 2005

LUS-16090

1982/US

**Re.: New national phase of PCT/CH02/00705 in the USA for  
„Intervertebral implant with filtable joint parts“  
in the name of Mathys Medizinaltechnik AG**

Dear Mr. Spaw,

Please find enclosed the Originals of the Declaration and Power of Attorney as well as the Assignment Document duly signed by all Inventors except of Prof. Max Aebi due to the problems mentioned in our letter of August 10, 2005.

Please file the enclosed Documents at your Patent Office as soon as possible. As soon as we receive the Document (Affidavit) from your side, we will forward it to our clients for signing.

We thank you very much for your cooperation in this matter.

Best regards.

Yours sincerely,



Encls.:

- Declaration and Power of Attorney (Original)
- Assignment Document (Original)